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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,847	12/21/2001	Thaylen K. Leany	03DV-9089	1175
7590	08/02/2004			EXAMINER MORRISON, NASCHICA SANDERS
John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metropolitan Sq. St. Louis, MO 63102			ART UNIT 3632	PAPER NUMBER
				DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/026,847	LEANY ET AL.
	Examiner Naschica S Morrison	Art Unit 3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 April 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

This is the fourth Office Action for serial number 10/026,847, Stud Mounting System, filed on December 21, 2001. Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,005,314 to Fisher et al. (Fisher) in view of Admitted Prior Art (APA) of Figure 1 in view of U.S. Patent 3,787,014 to Story et al. (Story) and further in view of U.S. Patent 4,933,809 to Boede et al. (Boede). With regards to claims 5-14, 16-18, and 20, Fisher discloses a motor comprising: a pair of endshields (58, 60); a cylindrical housing (54) extending between the endshields and having inner and outer surfaces; and a stator-rotor assembly (72, 80) mounted within the housing, wherein the inner surface extends between the stator-rotor assembly and the outer surface. Fisher does not disclose the housing including a plurality of fasteners attached thereto and extending outwardly therefrom. The APA of Figure 1 discloses a motor comprising a housing (12) including a plurality of fasteners (20) spaced circumferentially about the housing and extending outwardly therefrom for attachment to a support. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of Fisher by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because

one would have been motivated to enable the motor to be attached within an application as taught by the APA of Figure 1 (lines 3-6 of page 1 of the instant specification).

Fisher in view of APA of Figure 1 does not disclose the fasteners extending outwardly through openings in the housing. Story discloses a motor mount comprising a plurality of fasteners (66), inherently including a head, secured to the inner surface of the motor (by nuts as shown in Figure 2) and extending outwardly therefrom through attachment points/openings (56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of Fisher by providing openings therein and extending the fasteners outwardly through the openings, wherein the fasteners are inherently positioned between interior rotating motor components and the outer surface, as an alternative means for securing the fasteners to the motor as taught by Story (col. 3, lines 27-38) because one would have been motivated to prevent accidental "breaking off" of the fasteners. Fisher in view of APA of Figure 1 in view of Story does not disclose the openings in the housing being included in raised projections extending outwardly from the housing. Boede discloses an apparatus comprising a housing member (47) including a raised projection (58) defining a recess with an opening (56) therein, wherein a fastener (52) is attached to the inner surface of the recess. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of Fisher by providing raised projections extending outwardly therefrom and including openings therein for receipt of the fasteners because one would have been motivated to eliminate mounting bolt head protrusion above the inner surface of the housing as taught by Boede (col. 4, lines 49-

55). Fisher in view of APA of Figure 1 in view of Story and further in view of Boede does not teach the head of the fastener being substantially co-planar with the un-recessed portion of the inner surface of the housing. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the depth of the recess to be substantially equal to the height of the fastener head as is well known in the art such that the head is substantially co-planar with the un-recessed portion of the inner surface since it has been held since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. Regarding claims 1-3, the method steps recited therein are inherent to the apparatus as applied above.

Regarding claims 4 and 19, Fisher in view of APA of Figure 1 in view of Story and further in view of Boede does not disclose the fasteners secured to the housing inner surface by a weld, crimp, or adhesive. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the motor mount by substituting a weld, crimp, or adhesive for nuts attached to the fasteners (see Fig. 2 of Story) since welds, crimps, adhesives, and nuts are well known for their use in the fastening art and the selection of any of these known equivalents to secure the bolts to the housing surface would be within the level of ordinary skill in the art. Specifically regarding claim 4, the method step recited therein is inherent to the apparatus as applied above.

Regarding claim 15, Fisher in view of APA of Figure 1 in view of Story and further in view of Boede does not disclose the raised projections spaced circumferentially 90

degrees about the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of Fisher by spacing the projections at 90 degree intervals about the housing since it has been held that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) of Figure 1 in view of Story and further in view of Boede. With regards to claims 5, 6, 8-11 and 13, The APA of Figure 1 discloses a cylindrical motor housing (12) comprising an internal cavity housing rotating components of a motor (inherent; see pg. 3, lines 1-3 of instant specification); an inner surface (14) extending between the rotating components and the outer surface (16) of the housing, and a plurality of fasteners (20) spaced circumferentially about the housing and extending outwardly therefrom. The APA of Figure 1 does not disclose the fasteners extending outwardly through openings in the housing. Story discloses a motor mount comprising a plurality of fasteners (66) secured to the inner surface of the motor (by nuts as shown in Figure 2) and extending outwardly therefrom through attachment points/openings (56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of APA by providing openings therein and extending the fasteners outwardly through the openings, wherein the fasteners are inherently positioned between interior rotating motor components and the outer surface, as an equivalent alternative means for securing the fasteners to the motor as taught by Story (col. 3, lines 27-38). The APA of Figure 1 in view of Story does not disclose the

openings in the housing being included in raised projections extending outwardly from the housing inner surface. Boede discloses a motor mount comprising a housing member (47) including a raised projection (58) defining a recess with an opening (56) therein, wherein a fastener (52) is attached to the inner surface of the recess. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of APA by providing raised projections extending outwardly from the inner surface thereof and including openings therein for receipt of the fasteners because one would have been motivated to eliminate mounting bolt head protrusion above the inner surface of the housing as taught by Boede (col. 4, lines 49-55).

Regarding claim 7, the APA of Figure 1 in view of Story in view of Boede does not disclose the raised projections spaced circumferentially 90 degrees about the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of APA by spacing the projections at 90 degree intervals about the housing since it has been held that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

Regarding claim 12, the APA of Figure 1 in view of Story in view of Boede does not disclose the fasteners secured to the housing inner surface by a weld, crimp, or adhesive. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the motor mount by substituting a weld, crimp, or adhesive for nuts attached to the fasteners (see Fig. 2 of Story) since welds,

crimps, adhesives, and nuts are well known for their use in the fastening art and the selection of any of these known equivalents to secure the bolts to the housing surface would be within the level of ordinary skill in the art.

Response to Arguments

Applicant's arguments filed 4/19/04 have been fully considered, but are not persuasive.

Regarding applicant's argument that none of the applied references, alone or in combination, teach or suggest the fastener heads being potentially exposed to a rotating component such as the motor, examiner respectfully disagrees. The combination of Fisher, APA, Story and Boede as applied above as well as the combination of APA, Story and Boede as applied above each teaches the fastener heads being located within the interior of the housing and attached to the inner surface of the housing wall, therefore the fastener heads are positioned between the rotating motor components and the outer surface as claimed. Additionally the combinations each teach the inner surface of the housings extending between the rotating motor components and the housing outer surface (see Fisher and APA especially).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that Boede teaches away from the present invention, examiner respectfully disagrees. While the construction of Boede discloses the fasteners being used to secure the cover to the electrical component box, it is not clear how this construction teaches away from the present invention since the rejections above do not rely on Boede to teach mounting fasteners that extend outwardly through the housing. Additionally, regarding the fastener of Boede, examiner has not suggested reversing the orientation of the mounting fasteners of Boede as the rejections cited above do not rely on Boede to teach fasteners extending outwardly through the housing.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references themselves provide suggestion and motivation for the combinations and such motivations are specifically recited in the rejections above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.


Naschica S. Morrison
Patent Examiner
Art Unit 3632
7/27/04


RAMON O. RAMIREZ
PRIMARY EXAMINER